83 appears to have been grouped incorrectly. Either claim 83 should be in group V, or claims 80-83 should be in group I. Applicants invite the Examiner to make appropriate corrections.

Applicants are required to elect a group for examination on the merits. *Id.*, page 7. In response, Applicants elect Group I (claims 1-7, 9-18, 20-28, 30-39, 41-45, and 83-100), with traverse. Within elected claims 84-100, the Office also requires Applicants to elect a single disease for prosecution. *Id.*, page 5. The Office contends that this is an additional restriction, rather than an election of species. In response, Applicants have canceled claims 84-100, without prejudice or disclaimer. Applicants reserve the right to prosecute these claims in one or more future divisional applications.

Additionally, for any of groups I-XII [sic], the Office requires Applicants to elect a single species from among:

(I) Inhibitory Transcript: an antisense RNA, an RNA capable of forming a triple helix with a portion of the nucleic acid, or a ribozyme.

(II) Method of introducing the nucleic acids into target tissue or cell: a physical/mechanical method, or a chemical/biochemical agent.

Office action, pages 4-5. Applicants elect, with traverse, (I) antisense RNAs and (II) physical/mechanical methods. Claims 1-7, 9-18, 20-28, 30-39, 41-45, and 83-100 read on the elected species.

In traversing the restriction requirement, Applicants draw the Office's attention to M.P.E.P. § 803, which requires that there be a serious burden in examining the claims without restriction. In the present case, the Office has not shown that there would be a serious burden to examine many of the groups together, despite the Office's contention

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that the inventions are distinct. For example, the Office contends, "The inventions of groups I and II are patentably distinct each from the other because they use nucleic acids that have different structure and function." Office action, page 5. Yet the Office has indicated that the claims in these groups are identically classified in class 424, subclass 93.1. Group III is similarly classified. Certainly this indicates that the search of these groups together will not be problematic. According to the Office's own admission, the relevant art will be identified by searching a single subclass.

The Office characterizes the claims in each of groups I-IX as drawn to "a transgene of interest encoding a transcript under the control of PPARα." *See* Office action, pages 2-4. In order to clarify the record, Applicants note that this language is only recited in dependant claims 10-13 and 58-61.

The Office should also withdraw the election of species requirement. The Office has not established that there would be a serious burden in examining the claims without limitation to the class of inhibitory transcripts and the specific method by which the genes are introduced into the target. The Office is merely focusing on minor differences in the claims that are unlikely to be relevant to a determination of patentability. For example, while there are different ways of introducing a gene into a cell, it is not necessary to limit the claims to any particular method. All such methods (biochemical, mechanical, etc.) are routinely used in the art. It is not clear to Applicants why an election of a specific type of method is necessary to aid the Examiner's search. Applicants contend that no undue burden is placed on the Examiner to search the full scope of the group I claims. In any event, if the Office finds the elected species are

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allowable, the search must be expanded to include other allowable species. M.P.E.P. § 803.

If necessary, please grant any extensions of time required to enter this response and charge any additional required fees to our deposit account 06-0916.

Respectfully submitted,

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Dated: April 11, 2003

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